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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/849,525      08/29/97      LANZENDORFER

G      435-WCG

EXAMINER

HM12/0823

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ART UNIT

PAPER NUMBER

1619

DATE MAILED:

08/23/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/849,525

Applicant(s)

Lanzendorfer et al

Examiner

Shahnam Sharar h

Group Art Unit

1619

☒ Responsive to communication(s) filed on Aug 4, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 8, 11-16, and 18 is/are pending in the applicat

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 8, 11-16, and 18 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### DETAILED ACTION

The finality of the previous Office action is hereby withdrawn. Applicant's first submission after final filed on August 4, 2000 has been entered. Accordingly, claim 17 is canceled and claim 18 is added, claims 8, 11-16, 18 are now pending.

#### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 8, 13-16, and 18 rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al US Patent 5,145,781.

The instant claims are directed to cosmetic formulations comprising one or more flavonoids recited in claim 8, and methods of using thereof.

$\alpha$ - glycosyl rutin is disclosed by Suzuki et al, as superior to intact rutin. Further, Suzuki et al disclose the use of  $\alpha$ - glycosyl rutin as an anti-oxidant, stabilizer, preventative remedy, UV-absorbent, pharmaceutical and cosmetic formulations (see entire disclosure, especially abstract; col 6, lines 65-68; col 8 lines 45-68, col 10, line 1-30, and examples). Applicant is noted that recitation of "optionally" does not limit the instant formulations to further contain the optional components. Accordingly, Suzuki et al meet the limitations set forth in the instant claims.

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3. Claim 14 rejected under 35 U.S.C. 102(b) as being anticipated by Chikawa et al US Patent 5,153,000.

The instant claims are directed to cosmetic formulations comprising one or more of instant flavonoids.

Chikawa et al disclose topical formulations comprising various active components that can be incorporated into their formulations such as hesperidin, hesperetin, and the like compounds; as well as, cinnamated derivatives (see abstract, col 8 lines 35-45, and col 9 lines 5-8, co 10 line 55 .) Thus, Chikawa et al meet the limitations set forth in the instant claims.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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5. Claims 8, 11-16, 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al US Patent 5,561,116 in view of Whittle US Patent 5,466,452 and Nakanishi et al US Patent 5,008,441.

The instant claims are directed to cosmetic formulations comprising one or more flavonoids recited in claim 8, and methods of using thereof to provide immunosuppression.

Nakamura et al teach various compositions containing propolis components. Accordingly, propolis contain various organic compounds such as caffeic acid, cinnamic acid, ferulic acid, flavonols, quercetin, flavonones, etc.. (see abstract, col 1 and col 2 lines 36-44.) Nakamura et al also teach that  $\alpha$ - glycosyl flavonoids can also be used as the propolis components of their invention (see col 6 lines 42-47.) Nakamura et al teach that their formulations provide various therapeutic benefits and can be used in treatment of diseases such as viral diseases, immunopathies, rheumatism to promote recovery from said diseases (col 7 lines 51-62.) Finally, Nakamura et al indicate that other ingredients such as rutin,  $\alpha$ - glycosyl rutin, carotenoids, etc... (see col 8 lines 35-60.)

Whittle et al teach herbal containing compositions for treatment of auto-immune skin disorders such as eczema and psoriasis (see abstract). Whittle et al further disclose various types of Chinese plant names such as Gan Cao or Bei Yin Chen that contain various combination of flavonoids, and caffeic acids (see table 1 col 9-10, and claim 1)

As disclosed by Nakanishi et al, caffeic acid esters are well described in the art to possess anti-inflammatory properties when used in a suitable solvent (see col 3-4.)

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Nakamura, Whittle and Nakanishi teach various topical formulations containing herbal mixtures that can be used for inflammatory conditions, thus, their teachings are viewed to be in the same field of endeavor.

It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose . . . . The idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven , 626 F.2d 846, 205 USPQ 1069, 1072 (CCPA 1980). In the instant case, based upon the cited prior art and the fact that each of the claimed components of the instant composition is conventionally employed in the art for treating topical inflammatory skin disorders, it would have been *prima facie* obvious to one of ordinary skilled in the art at the time of invention to employ the instant flavonoids, a cinnamic acid derivative, and an antioxidant components in combination for their known functions and to optimize the amount of each additive, because he would have had a reasonable expectation to succeed in making a topical formulation that provide superior anti-inflammatory effects.

### ***Conclusion***

No claims are allowed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahnaz Sharareh, PharmD whose telephone number is (703) 306-5400. The examiner can normally be reached on Monday to Friday from 8:30 a.m. to 5:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. The fax

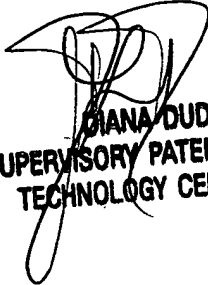
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phone number for this Group is 703-308-4556. Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is 703-308-1235.

*sjc, 8/21/2000*



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